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PRITZKAU PATENT GROUP, LLC  
993 GAPTER ROAD  
BOULDER CO 80303

**MAILED**

**SEP 14 2009**

**OFFICE OF PETITIONS**

In re Application of	:	
Kershman et al.	:	
Application No. 09/912,219	:	
Patent No. 6,858,241	:	DECISION ON PETITION
Filed: July 25, 2001	:	PURSUANT TO 37 C.F.R.
Issue Date: February 22, 2005	:	§ 1.378(B)
Attorney Docket Number: SK-3	:	
Title: FARINACEOUS SURFACE	:	
PRODUCT THAT IS TOASTER	:	
REHEATABLE AND METHOD	:	

This is a decision on the petition filed on July 27, 2009,<sup>1</sup> pursuant to 37 C.F.R. § 1.378(b) to revive the above-identified application.

This petition pursuant to 37 C.F.R. § 1.378(b) is **DISMISSED**.

**Background**

The patent issued on February 22, 2005. The grace period for paying the 3½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on February 22, 2009, with no payment received. Accordingly, the patent expired on February 22, 2009 at midnight.

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. § 1.378(b) must include:

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<sup>1</sup> Petitioner has indicated that a copy of this petition was first filed on March 11, 2009. The electronic record has been reviewed, and this indication is confirmed to be correct. It is noted that this prior submission contains a certificate of mailing dated March 3, 2009.

- (1) the required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);
- (2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1), and;
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent - the showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

With this petition, Petitioner has submitted the surcharge associated with a petition to accept the late payment of a maintenance fee as unavoidable, along with the 3½-year maintenance fee and a statement of facts.

Petitioner has met the first and second requirements of Rule 1.378(b). The third requirement of Rule 1.378(b) will be discussed below.

#### **The standard**

35 U.S.C. § 41(c)(1) states, *in pertinent part*:

The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay<sup>2</sup> is shown to the satisfaction of the Director to have been unavoidable.

37 C.F.R. § 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than

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<sup>2</sup> This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. § 1.378(b).

is generally used and observed by prudent and careful men in relation to their most important business.<sup>3</sup>

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."<sup>4</sup>

The burden of showing the cause of the delay is on the person seeking to revive the application.<sup>5</sup>

### **Application of the standard to the current facts and circumstances**

Petitioner's explanation of the delay has been considered, and it has been determined that it fails to meet the standard for acceptance of a late payment of the maintenance fee and surcharge.

The period for paying the 3½-year maintenance fee without the surcharge extended from February 22, 2008 to August 22, 2008 and for paying with the surcharge from August 23, 2008 to February 22, 2009. Thus, the delay in paying the 3½-year maintenance fee extended from February 22, 2009 at midnight to the prior filing of this petition on March 3, 2009.

With this petition, the Patentee has asserted that he submitted the maintenance fee and the \$65 surcharge for the late submission of the same on February 17, 2009, which was prior to the expiration of this patent. However, this submission was sent to an incorrect address, and returned to the sender on an unspecified date.

It follows that this patent became expired due to Petitioner's failure to submit the maintenance fee payment to the proper address. However, it is noted that the form contains the outdated address in the pre-printed certificate of mailing section, and that the form further indicates that it is

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3 In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

4 Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

5 Id.

"[a]pproved for use through 04/30/2009." As the submission was made prior to that date, it was reasonable for Petitioner to have addressed the mailing to the outdated address.

However, this petition cannot be granted at this time, for **the record does not contain a showing that Petitioner had steps in place to ensure the timely submission of the maintenance fee.** An adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Where the record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fee, 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR § 1.378(b).

### **Conclusion**

Any request for reconsideration of this decision **must** be filed within **TWO MONTHS** of the mailing date of this decision. Any such petition for reconsideration must be accompanied by the \$400 petition fee set forth in §1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, on request for reconsideration, it is extremely important that petitioner supply **any** and **all** relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Petitioner must provide documentation and address the deficiency noted above. If on request for reconsideration, the delayed payment of the maintenance fee is not accepted, then the maintenance fee is subject to refund following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed.

The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.378(e)". This is not a final agency action within the meaning of 5 U.S.C § 704.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski,

and may be submitted by mail,<sup>6</sup> hand-delivery,<sup>7</sup> or facsimile.<sup>8</sup> Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.<sup>9</sup>

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. Inquiries pertaining to the submission of maintenance fees should be directed to the Maintenance Fee branch at 571-272-6500.



Paul Shanowski  
Senior Attorney  
Office of Petitions

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6 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

7 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

8 (571) 273-8300- please note this is a central facsimile number.

9 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

**APPENDIX**

Portion of the MPEP relevant to the expiration of this patent

MPEP § 2510(II) sets forth, *in pertinent part*:

Maintenance fee payments not electronically submitted over the Internet, and correspondence related to maintenance fees may be addressed to:

Director of the United States Patent and Trademark Office  
Attn: Maintenance Fee  
2051 Jamieson Avenue, Suite 300  
Alexandria, Virginia 22314